

REMARKS

This Amendment is in response to the Office Action mailed September 9, 2004. The Office Action rejected claims 1, 3-7, 12, and 14-20 under 35 U.S.C. §103. Claims 1, 11, 12, and 16 have been amended. Claims 1, 3-7, 12, and 14-22 remain pending in the application. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejections Under 35 U.S.C. § 103

The Office Action rejected claim 1-3, 12-15, and 21 under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr., et al. ("Pare") (U.S. Patent No. 6,230,148) in view of Randle et al. ("Randle") (U.S. Patent No. 5, 974,146) and further in view of Simonoff (U.S. Patent No. 6,611,351).

The Office Action also rejected claims 5, 7-11, and 16-19 under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (U.S. Patent No. 6,230,148) in view of Carlson et al. (U.S. Patent No. 5,053,607) and further in view of Hills et al. ("Hills") (U.S. Patent No. 6,164,528).

The Office Action also rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (U.S. Patent No. 6,230,148) in view of Hills et al. (U.S. Patent No. 6,164,528) in view of Randle et al. (U.S. Patent No. 5,974,146) and further in view of Simonoff (U.S. Patent No. 6,611,351).

Applicants traverse this rejection in its entirety.

The Office Action acknowledges that, while Simonoff teaches 'printing a check', it fails to teach "printing a check ... at the location remote from the client computer" as claimed. However, the Office Action argues that rearranging the location of the printer would have been

obvious to one of ordinary skill in the art. The Office Action relies on *In re Japikse* (86 USPQ 70) for the proposition that rearranging parts of an invention involves only routine skill in the art.

In re Japikse involved the relocation of a starting switch of a hydraulic power press without changing the operation of the device. (See 86 USPQ 70, at 73 paragraph 2).

Applicants submit that *In re Japikse* is misapplied to the present claimed invention. The simple rearrangement of the start switch discussed in *In re Japikse* did not modify the operation of the hydraulic press. By contrast, placing the printer at a location remote from the client computer fundamentally alters how the claimed financial transaction is carried out. The location of the check printer modifies the operation of the invention, i.e., the nature of the financial transaction carried out. Placing the check printer at the client computer defeats the purpose of the invention since the client would still have to mail the check to the merchant. Placing the check printer at a remote location, along with the secure protocol claimed, enables a financial transaction where the merchant is assured of payment in real-time, thereby avoiding delays inherent in the traditional use of a check. Thus, the present claimed invention does not merely rearrange the location of an existing component as in *In re Japikse*, but instead provides a new way of carrying out a secure financial transaction using checks.

The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggests the desirability of such modification. (*In re Gordon* 219 USPQ 1125 (Fed. Cir. 1984)). Rarely will the skill in the art operate to supply missing prior art to reach an obviousness rejection. (*Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161 (Fed Cir. 1999)). For example, in *In re Gordon* the court held that although a prior art device could have been turned upside down, that did not make the

modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.

Applicants submit that the desirability of placing the check printer at a remote location is neither taught nor suggested by any of the cited prior art references nor the knowledge of one having ordinary skill in the art.

For at least the reasons discussed above, Applicants submit that the invention recited in claims 1, 3-7, 12, and 14-22 is patentably distinguishable over the cited prior art. Applicants respectfully request that the 35 U.S.C. § 103 rejections over Pare, Carlson, Randle, Simonoff and Hills be withdrawn.

Conclusion

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited.

Authorization is hereby given to charge our Deposit Account No. 19-2814 for any charges that may be due. Furthermore, if an extension is required, then Applicants hereby request such an extension.

Respectfully submitted,

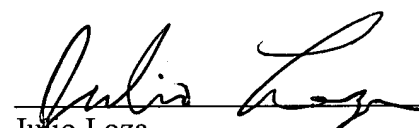
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I hereby certify that this document is being deposited on September 23, 2004 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313

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